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EXAMINER

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3625

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/823,084  
Filing Date: March 29, 2001  
Appellant(s): THOMAS ET AL.

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Joseph Lutz  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/11/2005

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection amending claim 1 and canceling claim 21 filed on 1/13/2005 was entered and acknowledged in the Advisory action mailed on 2/15/2005.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

6,594,700

GRAHAM

7-2003

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims: The grounds of rejection from the Final Office Action are reproduced below for the convenience of both the appellant and the Board of Patent Appeals.

Quote".....

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Graham.  
Regarding claim 1, Graham discloses a method comprising:

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registering an Internet service with a broker (see at least col.6, lines 1-49, "FIG. 4 is a conceptual diagram of a universal service broker interchange mechanism (USBIM), depicting interaction between the functional elements needed for brokering an interface between a service provider and a client needing service. In diagram 400, clients 410, 412 and 416 represent clients requiring a service. .... In accordance with the present invention, internal registry 402 is an internal registry providing rapid in-memory access to a database of service registrations. .... ". Note: Graham discloses that Internet services are registered with the USBIM, which corresponds to a broker.);

transmitting metadata, to the broker, describing at least one communication proxy, including at least one supported protocols, a type, and a location of the communication proxy (see at least col.6, lines 1-49, " FIG. 4 is a conceptual diagram of a universal service broker interchange mechanism (USBIM), .... The preferred embodiment of these service registrations utilizes Extensible Markup Language (XML) documents. .... In the present invention, service providers 420, 422 and 424 advertise services in the same manner as those of prior art; however, .... internal registry adapter servlets intercept the advertisement. ... Each protocol is associated with a different servlet that understands the details of the service advertising mechanism unique to that protocol. The unique protocol of the service provider is converted to a canonical representation of the service provider advertisement. .... Each time a new service provider advertises a new service or updated service, service provider protocol adapter servlets 406 convert the service provider's unique protocol into a canonical representation and update internal registry 402 with the new service information. At any one time, internal registry 402 contains an index of canonical representations of service advertisements from service providers 420, 422 and 424. ". Note: The information received from the service providers corresponds to transmitting metadata to broker and includes the type of communication proxy, that is adaptor servlet required to convert the service provider's protocol to a canonical representation, e.g. XML or SGML. Also see col.6 line 50-col.9, line 30); and

accessing, by the communication proxy, a web server to provide the Internet service to a client if the communication proxy is compatible with the client requirement (see at least col.6, line 66-col.7, line 38, " Clients 410, 412 and 416 may request a service using their own unique client protocol. However, as the advertisements for the services are stored in a canonical representation within internal registry 402, protocol adapter servlets are required for conversion of the client protocol to the canonical representation. Client protocol adapter servlets 404, which function similarly to the service provider protocol adapter servlets 406, are componentized mechanisms based on servlets, that listen for client lookup requests. As with service provider protocol adapter servlets, a different client protocol adapter servlet handles the details of client lookup for each protocol. Client protocol adapter servlets convert the client request in the requesting client's protocol to a canonical representation of the request. In addition, client protocol adapter servlets 404 also search internal registry 402 for the requested service advertisement in the index of service provider advertisements, and respond back to the requesting client with the results of the search using the client's request protocol.... ".Note: The adaptor servlet, which corresponds to the communication proxy, is compatible with the client environment and enables the client to request a service using the client's protocol from a service provider.

Regarding claim 2, Graham discloses a method as disclosed in claim 1. Graham further suggests downloading the communication proxy from the location to a node local to the client (see Fig.4 where client protocol adapter servlet 404 provides/downloads XML format, a canonical representation at a local node. It is already analyzed and discussed in claim 1 above that the adaptor servlet transforming the protocols to canonical representation, for example in XML format corresponds to a communication proxy, where it, on behalf of the client, handles the details of client lookup for each protocol ( client specifies the protocol it supports, see the example of printer service) searches internal registry 402 for the requested service in the registry and responds back to the client with the results of search using the client's request protocol. See also col.7, lines 32-38, "..... In effect, the client protocol adapter servlet brokers an interchange mechanism between the requester client and the service provider. In the case of brokering a UpnP-based service to a Jini client, this is accomplished by providing a Java interface and implementation based on the Service.Name: protocol associated with the service provider to the requesting client. ". Note: The, adapter servlet, which is the communication proxy provides the

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interface to establish communication between the client and the service provider and the adaptor servlets are downloaded to the client location from 402, the internal registry<sup>4</sup>, see FIG.4).

Regarding claim 3, Graham further discloses that in claim 1, the type of communication proxy is one of Java, common language runtime (CLR), component object model (COM), and Win32 binaries (see at least col.5, lines 38-52, and col.7, lines 20-32 and lines 49-58, wherein Graham discloses use of Java interface and component object model. The limitation in claim is directed to any one choice out of Java, common language runtime (CLR), component object model (COM), and Win32 binaries and Graham at least discloses use of two of them, thereby anticipating the claimed limitation. Also see col.6, lines 1-11, "..... In diagram 400, clients 410, 412 and 416 represent clients requiring a service. As discussed above, if a service provider is available for the needed service, such as one of service providers 420, 422 and 424, and the protocol is compatible with the requester client, a service discovery protocol may be used for establishing collaboration between the client and the service provider. ", and col.7, lines 32-38, "..... In effect, the client protocol adapter servlet brokers an interchange mechanism between the requester client and the service provider. In the case of brokering a UpnP-based service to a Jini client, this is accomplished by providing a Java interface and implementation based on the Service:Name: protocol associated with the service provider to the requesting client ").

Regarding claim 4, Graham further suggests that the method in claim 1, wherein the at least one supported protocol of the communication proxy includes at least one of hypertext transfer protocol (HTTP), simple mail transfer protocol (SMTP), simple object access protocol (SOAP), secure sockets layer (SSL/HTTPS), and secure HTTP (S-HUP) (see at least col. 6, lines 19-27, 50-65, col.7, line 50-col.8, line 5, which disclose use of XML and SOAP), is a lightweight protocol for exchange of information based on XML, hence use of SOAP is inherent with the use of XML based services. Also see col.6, lines 1-11, "..... In diagram 400, clients 410, 412 and 416 represent clients requiring a service. As discussed above, if a service provider is available for the needed service, such as one of service providers 420, 422 and 424, and the protocol is compatible with the requester client, a service discovery protocol may be used for establishing collaboration between the client and the service provider. ").

Regarding claim 5, the limitations are already covered by claims 1 and 4 and therefore analyzed and rejected on the same basis. See also col.7, lines 32-38, "..... In effect, the client protocol adapter servlet brokers an interchange mechanism between the requester client and the service provider. In the case of brokering a UpnP-based service to a Jini client, this is accomplished by providing a Java interface and implementation based on the Service:Name: protocol associated with the service provider to the requesting client. ".

Note: The fact that the adapter servlet [which corresponds to the communication proxy provided to the Jini client] is able to broker an interchange between the requestor client and the service provider will inherently mean that the adaptor servlet is compatible with the Jini client and is the communication proxy as required/specified by the Jini client to be able to receive the internet services from the service provider.

Regarding claims 6-8 and 10-12, their limitations are closely parallel to the limitations recited in claims 1-5 and are therefore, analyzed and rejected similarly based on same rationale. As regards interacting with a web server using the downloaded communication proxy to receive the desired Internet service, see at least col.6, line 1-col.9, line 40.

Regarding claim 9, Graham discloses that the method as in claim 6, wherein interacting comprises: dynamic interacting (see at least col.9, lines 17-30, which discloses that even though the client and the requested service on the service provider may be running at different protocols the information is exchanged between the two dynamically).

Regarding claims 13-20, their limitations are already covered in the claims 1-12 above and are therefore analyzed and rejected based on same rationale as being anticipated by Graham.

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**Response to Arguments**

2.2. Applicant's arguments, see Remarks pages 6-9 with respect to rejection of claims 1-20 under 35 USC 102 (e) as being anticipated by Graham have been considered but are not persuasive. The applicant argues that since Graham teaches that the protocol of the requestor client and the service provider are unimportant and that a client may have a protocol either same or different from the service provider (see Graham, col.6, lines 13-18) does not teach the recited limitation in the amended claims 1-21, that is the communication proxy by which a client accesses a web server to receive Internet service is required to be compatible with a client environment and therefore teaches away from the client's invention. The examiner respectfully disagrees for following reasons:

In response to applicant's argument that Graham teaches that the protocol of the requestor client and the service provider are unimportant and that a client may have a protocol either same or different from the service provider (see Graham, col.6, lines 13-18), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The reference Graham teaches that the communication proxy by which a client accesses a web server to receive Internet service is required to be compatible with a client environment (see at least col.6, line 66-col.6, line 12, "*Clients 410, 412 and 416 may request a service using their own unique client protocol. However, as the advertisements for the services are stored in a canonical representation within internal registry 402, protocol adapter servlets are required for conversion of the client protocol to the canonical representation. Client protocol adapter servlets 404, which function similarly to the service provider protocol adapter servlets 406, are componentized mechanisms based on servlets, that listen for client lookup requests. As with service provider protocol adapter servlets, a different client protocol adapter servlet handles the details of client lookup for each protocol. Client protocol adapter servlets convert the client request in the requesting client's protocol to a canonical representation of the request.* "). The adaptor servlet, which provides a canonical representation, such as XML or SGML format, corresponds to the communication proxy and is compatible with the client environment because it enables the client to request a service using the client's protocol from a service provider.

Sine the rejection of claims are on the basis of anticipation, under 35 USC. 102 (e) the argument that Graham reference teaches away is not relevant because the rationale of teaching away is applicable for obviousness type of rejections.

In view of the foregoing, the rejection of independent claims 1, 6, 13 and 17 and hence their dependencies, 2-5 & 21, 7-12, 14-16 and 18-20 under 35 USC 102 (e) as being anticipated by Graham is sustainable.

This is a Final Rejection."

Unquote.

**(11) Response to Argument:**

A. Applicant's arguments concerning rejection of claims 1-5, see pages

6-12

The applicant arguments, see page 7, lines 17-page 8, line 6 are not persuasive because examiner did not consider that the protocol adapter servlets are provided by the service provider. The protocol adapter servlets for both the client and for the service provider are provided by USBIM, the registry service. In the statement, "Note: The information received from the service providers corresponds to transmitting metadata to broker and includes the type of communication proxy, that is adaptor servlet required to convert the service provider's protocol to a canonical representation, e.g. XML or SGML. Also see col.6 line 50-col.9, line 30", presented on page 5, first paragraph of the final action, the examiner interpreted that Graham discloses transmitting metadata to USBIM, broker because, see col.6, lines 28-40 which suggests that USBIM receives information from service providers about their advertisements and this information received from the service providers by USBIM is metadata. Metadata, as known to one of an ordinary skill in the art, is data about data, for example, the title, subject, size of the advertisement file constitute metadata about the service provider's advertisement. Further, this information or metadata about the service provider's advertisement also includes the type of communication proxy it will need that is the type of adapter servlet it will require to be compatible with the service provider's protocol, see col.6, lines 28-40, " ....Each protocol is associated with a different servlet that understands the detail of the service advertising mechanism unique to that protocol....."(examiner has equated the adapter servlets to a communication proxy which helps communicate on behalf of service providers with the clients).

The applicant further argues, see page 8, line 7-col.9, line 25, that ".....Hence, Applicants respectfully submit that the teachings of Graham fail to disclose a communications proxy provided by a service provider, which interacts with a web



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server to provide a service to a client, as recited by the claimed subject matter..... Therefore, a prima facie case of anticipation of claims 1-5 has not been established and the rejection of claims 1-5 is therefore erroneous. Id.....”.. In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “communications proxy is provided by a service provider”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, none of the claims 1-20 recite that the communications proxy is provided by a service provider. The examiner has considered the claims 1-5 in its broadest possible interpretation (, see MPEP guidelines:- 2111 [R-1] Claim Interpretation; Broadest Reasonable Interpretation CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION) and these limitations in their broadest possible interpretation are anticipated by Graham as analyzed in the Final office action on pages 4-8. For example claim 1 recites:

registering an Internet service with a broker (see at least col.6, lines 1-49, “*FIG. 4 is a conceptual diagram of a universal service broker interchange mechanism (USBIM), depicting interaction between the functional elements needed for brokering an interface between a service provider and a client needing service. .... In accordance with the present invention, internal registry 402 is an internal registry providing rapid in-memory access to a database of service registrations. ....*”.

Note: Graham discloses that Internet services are registered with the USBIM, which corresponds to a broker.);

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transmitting metadata, to the broker, describing at least one communication proxy, including at least one supported protocols, a type, and a location of the communication proxy (see at least col.6, lines 1-49, & FIG. 4. *In the present invention, service providers 420, 422 and 424 advertise services in the same manner as those of prior art; however, ..... internal registry adapter servlets intercept the advertisement. ... Each protocol is associated with a different servlet that understands the details of the service advertising mechanism unique to that protocol. The unique protocol of the service provider is converted to a canonical representation of the service provider advertisement. ....* ". As further analyzed above, Graham discloses transmitting metadata to USBIM, broker because, see col.6, lines 28-40 which suggests that USBIM receives information from service providers about their advertisements and this information received from the service providers by USBIM is metadata. Metadata, as known to one of an ordinary skill in the art, is data about data, for example, the title, subject, size of the advertisement file constitute metadata about the service provider's advertisement. Further, this information or metadata about the service provider's advertisement also includes the type of communication proxy it will need that is the type of adapter servlet it will require to be compatible with the service provider's protocol,); and

accessing, by the communication proxy, a web server to provide the Internet service to a client if the communication proxy is compatible with the client requirement ,see at least col.6, line 66-col.7, line 38, which teaches that it is possible for clients to access the advertising services provided by the service provider via the adaptor servlet, which acts as the communication proxy and therefore it is compatible with the client requirement.

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The applicant, in his arguments, "Explanation Why such limitations Render the claims Unanticipated by the Prior Art", see AB, page 9, line 26-page 12, line 21 mainly argues two points, that is (a)Graham does teach that " a communication proxy is provided by the service provider ", and (b) Graham's invention offers solutions to allow interoperability of devices and services that implement different service discovery protocols and the protocols of the requestor client and the service provider are unimportant...Graham teaches that a protocol of the client protocol adapter servlet must match a protocol of the client and that a protocol of the service provider protocol adapter servlet must match a protocol of the service provider, interchange mechanism brokered by the client protocol adapter servlet is not required to match communications proxy type specified by a client, as recited by Claim 1. The examiner respectfully disagrees for the following reasons:

In response to applicant's arguments the examiner that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., " communications proxy is provided by a service provider") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, none of the claims 1-20 recite that the communications proxy is provided by a service provider.

In response to applicant's argument that Graham's invention offers solutions to allow interoperability of devices and services that implement different service discovery

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protocols and the protocols of the requestor client and the service provider are unimportant... Graham teaches that a protocol of the client protocol adapter servlet must match a protocol of the client and that a protocol of the service provider protocol adapter servlet must match a protocol of the service provider, interchange mechanism brokered by the client protocol adapter servlet is not required to match communications proxy type specified by a client, as recited by Claim 1, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In view of the foregoing, rejection of claims 1-5 is sustainable as being anticipated by Graham.

**B. Applicant's arguments concerning rejection of claims 6, 10-12 and 17-19:**

Since limitations of claims 6, 10-12 and 17-19 were closely parallel to the limitations of claims 1-5 the examiner indicated the same rationale as used for claims 1-5 in rejecting claims 6, 10-12 and 17-19.

The applicant's argues, see page 12, lines 22-30, that claims 6, 10-12 and 17-19 are not anticipated by Graham for the same reasons as applicable earlier for claims 1-5. The examiner respectfully disagrees in view of the analysis given above for claims 1-5.

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The applicant further argues, see page 13, lines 26-30, that, Accordingly, based on the cited passage above, Applicants respectfully submit that although the client protocol adaptor servlet is responsible for brokering the mechanism of interchange between the client and service provider, the client adapter servlet is not downloaded from a location specified by metadata received from a broker and is thus not used for interacting with the web server to receive the desired Internet service, as recited by Claims 6 and 17". The examiner respectfully disagrees. As indicated in the final action the adaptor servlet corresponds to communication proxy. See col.9, lines 10-40 and Fig.7, "...FIG. 7 is a flowchart illustrating the process for a client requesting a service using client protocol adapter servlets. The process begins by determining the client service request protocol (step 702). Then, a determination is made as to whether an adapter servlet is available for the unique protocol of the client service request (step 704). If no servlet is available for the specific protocol, the process ends. (39) If, on the other hand, a servlet is available, the client protocol adapter servlet receives the request for service from a client, using the client's own unique protocol (step 706). .....".

Note: In response to the clients' request for an Internet service, the steps of (a) determining (by the Internal Registry "402", see Fig.4) the type of client service request protocol and if a corresponding adaptor servlet is available and (b) then adaptor servlet receiving the request for service from the client will inherently include the step of client receiving information, that is metadata about the availability of the adaptor servlet corresponding to the client request protocol and its location enabling the client to access it and download it to act as communication proxy to access the web server to receive the desired service.

C. **Applicant's arguments concerning rejection of claims 13-16:**

The applicant argues, page 15, line 31-page 17, line 34, that Graham fails to anticipate claim 13. The examiner respectfully disagrees. Since limitations of claim 13, were closely parallel to the limitations of claims 1-12 the examiner indicated the same rationale as used for claims 1-12 in rejecting claims 13-20. The examiner analyzes the limitations of claim 13 as follows:

The step of receiving at least one Internet service registration is covered by the step of "registering an Internet service ..." in claim 1. The step of receiving a request to locate a client-desired Internet service is covered by the steps of "accessing , by the communication proxy, a web server to provide Internet service to a client if the type of the communication proxy matches a communication proxy specified by the client" in claim 1 and the step of " interacting with a web server using the downloaded communication proxy to receive the desired Internet service " in claim 6 wherein the communication proxy has been downloaded from allocation specified by the metadata received from the broker. These steps inherently include the step of receiving a request to find a client desired Internet service as analyzed above in paragraph 11B above. The steps of matching the request with the Internet service registration to identify a communications proxy of the communication proxy type is also analyzed in paragraph 11B above , "See col.9, lines 10-40 and Fig.7, "... FIG. 7 is a flowchart illustrating the process for a client requesting a service using client protocol adapter servlets. The process begins by determining the client service request protocol (step 702). Then, a determination is made as to whether an adapter servlet is available for the unique protocol of the client service request (step 704). If no servlet is

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*available for the specific protocol, the process ends. (39) If, on the other hand, a servlet is available, the client protocol adapter servlet receives the request for service from a client, using the client's own unique protocol (step 706). ....*. Note: In response to the clients' request for an Internet service, the step of determining (by the Internal Registry "402", see Fig.4) a client service request protocol and if a corresponding adaptor servlet is available the adaptor servlet receives the request for service from client corresponds to identifying a communications proxy, that is an adaptor servlet of the type required by the client.


**D. Applicant's arguments concerning rejection of claims 8, 9, and 20:**

The applicant argues, page 18-20, that Graham does not disclose dynamic interacting with a web server using the downloaded communication proxy to receive the desired Internet service. It has been analyzed above, see paragraph 11, B above, that client is able to interact with a web server of service provider using the downloaded communication proxy to receive the desired Internet service. Since the client is able to connect and receive the desired Internet service when it needs, see col.9, lines 17-25, "*....) If, on the other hand, a servlet is available, the client protocol adapter servlet receives the request for service from a client, using the client's own unique protocol (step 706). ....* The servlet then converts the client service request protocol.....the internal registry may be searched for an advertisement for the requested service from a service provider... ", it corresponds to dynamic interacting. The applicant's arguments about client look up mechanism are not persuasive because the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the

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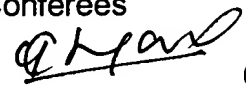
differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,  
  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
July 8, 2005

Conferees

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